



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,870	05/26/1999	ANDREW H. SEGAL	3378/80489	2018
29933	7590	03/11/2005	EXAMINER	
PALMER & DODGE, LLP KATHLEEN M. WILLIAMS 111 HUNTINGTON AVENUE BOSTON, MA 02199			BELYAVSKYI, MICHAIL A	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4/2

Office Action Summary	Application No. 09/318,870	Applicant(s) SEGAL, ANDREW H.	
	Examiner Michail A Belyavskyi	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 13, 14, 17-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13-14, 17-20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1644

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/15/04 has been entered.

2. It is noted that Applicant stated that claims 1-8 and 13-25 are pending, however, claims 15-16 and 21 have been cancelled in Applicant's amendment filed on 02/28/03.

Claims 1-8, 13-14, 17-20 and 22-25 are pending.

In view of the amendment, filed on 11/15/04 the following new grounds of rejection is set forth below

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 13-14, 17-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiserodt et al. (US Patent 6,277,368) in view of the Known fact disclosed in the Specification on pages 52-54 and 66 – 68.

US Patent '368 teaches a method of stimulating an immune response in a mammal, including to selected antigen, comprising administering a vaccine comprising a primary tumor cells and cytokine-secreting cells (see entire document, Abstract in particular). It is noted that "cytokine-coated cells" of the present invention are obtained by mixing cell that already express an antigen, a tumor cell antigen for example, with engineered cytokines that can become membrane-bound (see page 79 lines 9-25 of the instant Specification in particular). US Patent '368 teaches that cytokines secreted by said cytokine-secreting cells are exogenous to primary

Art Unit: 1644

tumor cells (see column 7, lines 25-40 in particular). US Patent '368 teaches that cytokine is a GM-CSF, that is a ligand for GM-CSF receptor (see column 7, lines 31, or column 10, lines 52-65 in particular). US Patent '368 teaches that said cytokines can be membrane-bound capable of potentiating an immunological response against the tumor-associated antigen (column 15, lines 36-45 in particular). US Patent '368 teaches a immunogenic composition comprising 2 population of cells: first population is tumor cells i.e. specific antigen expressing cells and second population is the cytokine-producing cells (see column 15, line 35-40 and claim 9 in particular). Cytokines secreted by said second cytokine-secreting cells would be exogenous cytokines that are produced outside of first population of antigen expressing cells, that will become "cytokine-coated cells", wherein said cytokine of said cytokine-coated cells is exogenous to said antigen expressing cell. In other words US Patent '368 teaches the administering an immunogenic composition comprising cell comprising antigen that are admixed with cytokine, produced by cytokine-secreting cells. Moreover, US Patent '368 teaches that it is preferable that cytokine attached to the cell membrane to keep it in the vicinity of bystander tumor antigen comprised in the vaccine (see column 16, lines 28-35 in particular). US Patent '368 teaches that when particular cytokines have potent immunostimulatory activity but do not occur naturally in a membrane-bound form, it is possible to engineer membrane-bound forms, with a high degree of lipophilicity (see column 16, line 50-65 in particular). US Patent '368 teaches that cytokines can be engineered to become stable associated with the plasma membrane (see column 16, lines 50-65 in particular). US Patent '368 teaches that said vaccine composition can be attenuated (see overlapping columns 23 and 24 in particular). US Patent '368 teaches the advantage of using a membrane-bound cytokines over soluble cytokines to increase an immune response to an antigen comprises by the cell (see column 16, lines 40-50 in particular).

US Patent '368 does not explicitly teaches engineered cytokine wherein said engineered cytokine comprises a cytokine and a moiety heterolous to said cytokine wherein said moiety binds to said cell, as claimed in claim 1-2, 13 or 15 or specific opsonin-enhanced cells as recited in claims 3-8 and 20.

The Known fact disclosed in the Specification on pages 52-54 and 66 – 68 teaches that it is conventional and within the skill of the art to produce : (i) an opsonin-enhanced cells, wherein opsonin of said cells is mannose binding protein or alph' chain of C3b to allow more efficient binding, engulfment and internalization of the antigen; (ii) an engineered cytokine by attaching the lipid , e.g. a long-chain fatty acid, for example palmitate or GPI moiety to said cytokine to permit a complex to become stable associated with plasma membrane. In other words, at the time the invention was made one skill in the art would know how to produced an engineered membrane-bound form of cytokine, comprising heterologous moiety wherein said moiety binds to the cell.

Art Unit: 1644

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the teaching of the Known fact disclosed in the Specification on pages 52-54 and 66 – 68 to those of US Patent '368 to obtain a claimed method of stimulating a mammal to a selected antigen, comprising administering composition comprising an opsonin-enhanced cells and engineered cytokine comprising a lipid or GPI moiety or palmitate.

One of ordinary skill in the art at the time the invention was made would have been motivated to do so, because engineered cytokine wherein lipid, e.g. a long-chain fatty acid, for example palmitate or GPI moiety is attached to said cytokine permits said complex to become stable associated with plasma membrane of the cell and an opsonin-enhanced of said cells, allows more efficient binding, engulfment and internalization of said engineered cytokine into said cell as taught by the known fact disclosed in the Specification on pages 52-54 and 66-68. Thus the engineered cytokines that will become membrane-bound can be obtained that can be further used instead of cytokine-producing cells in the method taught by US Patent '368, because US Patent '368 teach the advantage of using a membrane-bound cytokines over soluble cytokines to increase an immune response to an antigen comprises by the cell.

From the combined teaching of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

5. No claim is allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskiy whose telephone number is 571/272-0840. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571/272-0841.

The fax number for the organization where this application or proceeding is assigned is 571/273-8300

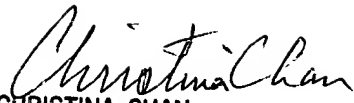
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/318,870

Page 5

Art Unit: 1644

Michail Belyavskyi, Ph.D.
Patent Examiner
Technology Center 1600
February 24, 2005


CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600